

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

GEN-PROBE INCORPORATED,

Plaintiff,

vs.

BECTON DICKINSON AND COMPANY,

Defendant.

CASE NO. 09-cv-2319 – BEN (NLS)

**ORDER OVERRULING GEN-
PROBE’S OBJECTIONS TO MAY
30, 2012 ORDER RESOLVING
JOINT MOTION FOR
RESOLUTION OF DISCOVERY
DISPUTE (TWENTIETH
DISPUTE)**

[Doc. No. 359]

This is a patent infringement action. Plaintiff Gen-Probe Incorporated (“Gen-Probe”) alleges that Defendant Becton Dickinson & Company (“BD”) infringes its Automation Patents. Presently before the Court are Gen-Probe’s objections to Magistrate Judge Stormes’ May 30, 2012 Order resolving the parties’ joint motion for resolution of a discovery dispute (“May 30, 2012 Order”). BD filed a response to the objections. Having considered the parties’ arguments, and for the reasons set forth below, the Court **OVERRULES** Gen-Probe’s objections to the May 30, 2012 Order.

BACKGROUND

As Judge Stormes’ Order explains, Gen-Probe contracted with RELA, Inc. to develop an automated nucleic acid detection system in 1996. RELA hired Mark Toukan as an independent contractor to work on the project. Gen-Probe claims that everyone working on the project was required to assign their rights to anything resulting from the project to RELA, although a copy of Mr.

1 Toukan's contact assigning his rights cannot be located. In 2002, one of Gen-Probe's outside patent
2 attorney's, Richard Wydeven, contacted Mr. Toukan about his work on the project by email and phone.
3 These communications are the subject of this discovery dispute.

4 This dispute was initially brought before the Magistrate Judge in the parties' fifteenth discovery
5 dispute. Judge Stormes found that the communications were subject to the attorney-client privilege
6 because Mr. Toukan was the equivalent of an employee. In reaching this conclusion, Judge Stormes
7 accepted Gen-Probe's assertion in its privilege log that all the communications related to "patent
8 application" and "patent matters" and Gen-Probe's assertion that Mr. Wydeven communicated with
9 Mr. Toukan about matters of patentability.

10 The issue arose again during the deposition of Gen-Probe's Chief Intellectual Property
11 Counsel. The witness was instructed not to answer numerous questions as protected by the attorney-
12 client privilege. In response, the parties filed their twentieth discovery dispute in which BD sought
13 to compel the production of communications between Mr. Wydeven and Mr. Toukan. On May 22,
14 2012, Judge Stormes ordered Gen-Probe to produce the Wyveden-Toukan communications for *in*
15 *camera* review. After conducting an *in-camera* review, Judge Stormes found that the primary purpose
16 of the communications was to obtain an assignment of rights from Mr. Toukan and ordered the
17 documents produced. Gen-Probe objects to that order and seeks to reestablish the privilege over those
18 communications.

19 Gen-Probe asserts that the communications concern only a patentability investigation
20 conducted to provide legal advice to Gen-Probe and the communications are protected by the attorney-
21 client privilege. BD claims that the communications were an attempt to obtain an assignment of Mr.
22 Toukan's rights as an inventor and that Mr. Toukan is in fact an omitted inventor of a component of
23 the Automation Patents, making the communications relevant to Gen-Probe's standing and BD's
24 invalidity defense.

25 LEGAL STANDARD

26 Federal Rule of Civil Procedure 72(a) provides that whenever a magistrate judge issues a
27 written order deciding a non-dispositive pretrial matter, "[a] party may serve and file objections to the
28 order within 14 days after being served with a copy." "The district judge in the case must consider

1 timely objections and modify or set aside any part of the order that is *clearly erroneous* or is *contrary*
2 *to law*.” FED. R. CIV. P. 72(a) (emphasis added); *see also* 28 U.S.C. § 636(b)(1)(A). The magistrate
3 judge’s decision on non-dispositive matters is entitled to “great deference” by the district court. *See*
4 *United States v. Abonce-Barrera*, 257 F.3d 959, 969 (9th Cir. 2001). To conclude that a magistrate
5 judge’s decision was clearly erroneous, the district court must arrive at a “definite and firm conviction
6 that a mistake has been committed.” *Folb v. Motion Picture Indus. Pension & Health Plans*, 16 F.
7 Supp. 2d 1164, 1168 (C.D. Cal. 1998) (citation omitted), *aff’d*, 216 F.3d 1082 (9th Cir. 2000); *see also*
8 *Concrete Pipe & Products of Cal., Inc. v. Constr. Laborers Pension Trust for S. Cal.*, 508 U.S. 602,
9 622 (1993).

10 DISCUSSION

11 Gen-Probe objects to Judge Stormes’ finding that the overall purpose of the communications
12 between Mr. Wydeven and Mr. Toukan was to obtain an assignment of rights rather than to obtain
13 legal services. In determining whether the attorney-client privilege applies, “the central inquiry is
14 whether the communication is one that was made by a client to an attorney for the purpose of obtaining
15 legal advice or services.” *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 805 (Fed. Cir. 2000).
16 As Judge Stormes acknowledged, just the inclusion of the assignment of rights in a document does
17 not destroy the privilege, if the overall tenor of the document indicates a request for legal advice or
18 services. *Id.* at 806.

19 After reviewing the communications *in camera*, Judge Stormes determined that the
20 communications were an effort by Gen-Probe to convince Mr. Toukan to assign his rights in the
21 invention and as such, were not confidential communications for the purpose of securing legal advice.
22 As Judge Stormes explained, the communications were about obtaining Mr. Toukan’s assignment of
23 his rights as an inventor. Gen-Probe’s claim that Mr. Toukan would have already assigned his rights
24 as part of his work for RELA does not change the substance of the communications. The
25 communications focus almost entirely on obtaining an assignment of Mr. Toukan’s rights as an
26 inventor. The initial email seeks to confirm Mr. Toukan’s contribution to the invention of the
27 luminometer and every following communication seeks an assignment of Mr. Toukan’s rights.

28 ///

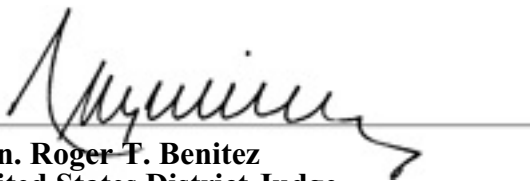
1 Having reviewed Gen-Probe's objections, the Court concludes that Judge Stormes'
2 determination was neither "clearly erroneous" nor "contrary to law."

3 **CONCLUSION**

4 For the foregoing reasons, Gen-Probe's objections to the May 30, 2012 Order are
5 **OVERRULED.**

6 **IT IS SO ORDERED.**

7
8 **DATED: July 18, 2012**

9
10 
11 **Hon. Roger T. Benitez**
12 **United States District Judge**